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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,158	07/28/2000	Raghunath Vitthal Chaudhari	5728	2931

7590

09/23/2003

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 09/23/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/628,158

Applicant(s)

CHAUDHARI ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,8-18 and 20 is/are rejected.
- 7) ☐ Claim(s) 2 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Final Rejection

The Status of Claims

Claims 1-2 and 8-18, and 20 are pending.

Claims 1 and 8-18, and 20 have been rejected.

Claims 3-7 have been canceled.

Claims 2 and 19 have been objected.

Claim Rejections-35 USC 112

1. Applicants' argument filed 6/30/2003 have been fully considered but they are not persuasive.

The previous rejection of Claim 1 has been withdrawn due to the modification in the amendment. However, there is still an issue in the claim in the amendment.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Double Patenting

The rejection of Claims 1 and 3-19 provisionally under the judicially created doctrine of double patenting over claims 18-19, 21-23, and 25-36 of copending Application No.

09662,035 has been withdrawn due to the modification made in the amendment.

Claim Rejections-35 USC 103

Rejection of Claims 1 and 8-18 and 20 under 35 U.S.C. 103(a) as being unpatentable over Elango et al (U.S. 4,981,995) in view of Chaudhari et al (U.S. 6,093,847) .

The rejection of Claims 1 and 8-18, and 20 under 35 U.S.C. 103(a) as being obvious over Elango et al (U.S. 4,981,995) in view of Chaudhari et al (U.S. 6,093,847) is maintained for reasons of the record in paper no. 11.

Response to Argument

2. The applicants argue the following issue:
 1. the prior art references have used two different catalysts in comparison with the present invention;
 2. the prior art references do not use the pressure as low as 50 psig;
 3. none of the references have disclosed that the water is in the range of 1 to 6 %(v/v) of the total mixture;
 4. the claimed process is involved in that the reaction vessel is flushed with an inert gas after the reaction process unlike the prior art .

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The applicants' arguments have been noted, but these arguments are not persuasive.

First, with regard to the first argument, the Examiner has noted applicants' argument. However, on the contrary to applicants' assertion, the prior art references do indicate the use of the palladium catalyst. Therefore, the prior art references are relevant to the claimed invention.

Second, regarding the second argument, the Examiner agrees.

Third, concerning the third argument, the Examiner has noted applicants' argument. However, the secondary Chaudhari et al reference does disclose that during the process of preparing ibuprofen water (4% v/v) (see col. 4, example 3) is employed in the presence of the palladium catalyst. Therefore, the prior art reference is relevant to the claimed invention.

Fourth, with respect to the fourth argument, the Examiner has noted applicants' argument. However, Elango et al does teach that step before the initiation of the reaction process. It has been held that merely reversing the order of steps in a multi-step process is not a patentable modification absent unexpected or unobvious results. EX parte Rubin, 128 U.S.P.Q. 440 (P.O.B.A. 1959).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*** Taylor Voh
9/13/23

Alan L Rotman
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SUPERVISORY PATENT EXAMINER
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